

Application No. 09/989,202
Amendment Dated January 6, 2005
Reply to Office Action of December 6, 2004

REMARKS/ARGUMENTS:

The final Office Action noted that the applicant argued that both Kwak and Hyodo lack a search capability for a user to "frame a search request for a toll-free telephone number or other company information based on information taken from advertising for a product or service". The final Office Action responded by contending that claims 1, 9, 17, 20 do not require the user to "frame a search request for a toll-free telephone number or other company information based on information taken from advertising for a product or service" Instead, they merely recite "may frame a search request for a toll-free telephone number or other company information based on information taken from advertising for a product or service". Thus, in view of the final Office Action, the claim language is broad enough to be interpreted by the examiner as in the previous Office Action.

The finding is traversed. The presence of "may" in a claim requires that the capability for performing what follows after the "may" term be present in the cited art to justify rejection for obviousness. Such is not properly ignored when deciding patentability.

Nevertheless, in an effort to overcome the sole reason expressed for maintaining the rejection and finding the applicant's arguments unpersuasive, the word "may" was stricken and the verb "frame" changed to "frames" in claims 1 and 9. With respect to claims 17 and 20, the term "allow" was changed to "frame" and the phrase "to be framed" was stricken. Thus, the claim language of the independent claims should now be deemed consistent with each other in light of the comments in the final Office Action.

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No new issues are raised by this amendment. By amending the claims to change the phrase "may frame" in claims 1 and 9 to "frames" and by using the phrase "frame" instead of "allow" and omitting the phrase "to be framed" in claims 17 and 20, no new subject matter is being introduced into the claims that would require either further consideration or search on the part of the patent examiner over that of the original claim language.

The previous arguments raised by the applicant in the Amendment to the claim rejection, which were not otherwise commented upon by the patent examiner, are repeated below for convenience for the Examiner. The application is now believed to be in a form for allowance.

Claims 1-22 are rejected under 35 USC § 103 as being unpatentable over Kwak (US 2002/0198933), in view of Hyodo (US 5,937,390). According to the Office Action, it would have been obvious to one of ordinary skill in the art to combine the teachings of Kwak and Hyodo "in order to attract customers by providing a toll free number for customers to call". This rejection is traversed.

The patent to Kwak at paragraph [0037] advises about a website Lebx.com that allows advertising to list classified ads and listings. The patent to Hyodo reveals storing advertisements and toll free 800 numbers associated with the advertiser in an advertising information storage section 11 that a user may access. The examiner contends that modifying Kwak by Hyodo would be obvious to a person of ordinary skill in the art so as to attract customers by providing toll-free numbers for customers to call. The end result would be that the classified ads and listings that are advertised (Kwak) would include storage of 800 toll-free numbers associated with the advertiser.

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In contrast, the independent claims 1, 9, 17 and 20 each call for the ability "to frame a search request for a toll-free telephone number or other company information based on information taken from advertising for a product or service." Both Kwak and Hyodo lack such a search capability for a user. Paragraph [0027] of Kwak merely mentions that it enables pre-existing customers to list classified ads and auction listings of Labx.com. Nothing is mentioned about framing a search request based on information from advertising. Hyodo at col. 4 lines 11-37 discusses a seven step shopping procedure. Step 1 mentions that on-line advertising displays and explanation of products and a toll-free number, but nothing is mentioned about framing a search request based on information from advertising.

To assist the examiner in understanding the claimed invention, consider the following excerpt from page 4 lines 8-18 of the present application:

Accordingly, the present invention provides an Internet-based directory information system for providing toll free telephone numbers and other information of companies, where the numbers are provided based primarily or solely on information from a television or radio advertisement for products or services from such companies. The present invention also provides a telephone-based directory information system for providing toll free telephone numbers and other information of companies, where the numbers are provided based primarily or solely on information from an advertisement for products or services from such companies.

The present invention also provides a method for providing the toll free telephone number and other information of a company via the Internet or

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telephone based on the air date, approximate air time, and airing station or other presentation information of an advertisement for goods or services from that company.

The main deficiency in locating a toll free number or any number for that matter with conventional techniques is that unless the exact name of the person or company in whose name the number is known, the search request for the number will be fruitless. The advertised numbers for goods and services may be that of "marketing" companies, as opposed to that of the parent company or individual retailing the goods or services.

Thus, a person calling toll free information at 1-800-555-1212 would not obtain a desired toll free number from the toll free information service unless the person provided the exact name of the listed entity with the toll free information service. If all the person remembered about the toll free number that had been advertised in a radio or television ad was the product or deal that have been offered, providing such information to the toll free information service would not help in the retrieval of the toll free number that had aired.

As far as the inventor is aware, search engines used on the Internet are not set up to correlate such toll free numbers with criteria other than the exact name of the listing with the toll free number information service. Indeed, such search engines are useful where constant, non-variable search criteria is used. Since the criteria is variable, as is the case for advertising toll free numbers for which advertisers are ever changing the choice of media, time, city, etc. to run the advertisement containing the toll free number, such variable criteria needs to be updated constantly on a website to stay current for a search request to lead to meaningful results. In view of the need to provide

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a toll free number based on search criteria that did not include the name or address of toll free number owner listed with an information service that the present invention came about. Indeed, it is not even necessary in accordance with the invention for the identity of the name or address of the listed toll free number owner to be known to enable retrieval of the toll free number from framing a search request from advertising information.

The examiner is invited to explore www.calltollfree.com to get an idea of a sampling of what questions a visitor would answer that would give the desired results (although the website is not functioning to actually provide the results).


CORRESPONDENCE AND FEES:

In the event that there are fees necessitated by this response, authorization is hereby given to charge Deposit Account No. 03-3839. Please address all correspondence to Intellectual Property Docket Administrator, Gibbons, Del Deo, Dolan, Griffinger & Vecchione, One Riverfront Plaza, Newark, NJ 07102-5497. Should there be any questions or other matters that may be resolved by a telephone call, the Examiner is invited to contact the applicants' undersigned attorney at the number below. Any communications should be sent directly to him at the number below.

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Respectfully submitted,

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